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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

Applicant: Chiang, *et al.*

Docket No.: 066040/9651

Serial No.: 09/530,663

Group Art Unit: 1638

Filed: July 11, 2000

Examiner: O. Zaghmout

For: "GENETIC ENGINEERING OF LIGNIN BIOSYNTHESIS IN PLANTS"

RESPONSE TO RESTRICTION REQUIREMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Response is made to the requirement for restriction of the application under 35 U.S.C. §121 and §372 set forth in the Office Action mailed July 31, 2001. In the Office Action, the Examiner held that the application contains five groups of claims drawn to five different inventions: Group I (claims 1-28 and 50-53), drawn to a method for altering the growth characteristics of a plant and resulting plant. Group II (claims 29-32 and 45-48), drawn to an isolated and purified DNA molecule comprising a DNA segment comprising a transcriptional regulatory region of plant 4CL gene. Group III (claims 33-38 and 49), drawn to a method of imparting disease resistance to a plant tissue and resulting plant. Group IV (claims 18-28, 39-40 and 43-44), drawn to a method for altering the lignin content or structure in a plant and resulting plant. Group V (claims 18-28 and 41-42), drawn to a method for altering the cellulose content in a plant and resulting plant.

Applicants provisionally elect, with traverse, Group I, corresponding to claims 1-28 and 50-53. Applicants respectfully submit, however, that the restriction requirement is improper, and request reconsideration of the restriction requirement.

A proper requirement for restriction requires that: (1) the inventions must be independent or distinct as claimed; and (2) there must be a serious burden on the Examiner if restriction is not required (MPEP §803). Applicants respectfully traverse the restriction requirement because there would be no serious burden on the Examiner if restriction were not required.

In the Office Action, the Examiner asserted that the inventions listed as Groups "I-X", allegedly Groups I-V, did not relate to a single general inventive concept under PCT Rule 13.1. The Examiner recited that under PCT Rule 13.2, Groups I-V,

"lack the same or corresponding special technical features for the following reasons: since the method of claim 1 is known in the art as evidenced by the Kajita *et al.* reference (Plant Cell Physiol. 1996 Oct 37:957-965), it does not constitute a special technical feature within the meaning of Rule 13.2. Since Claim 1 lacks novelty, unity of invention is lacking." (See pg. 3 of Office Action)

Furthermore, the Office Action recited that because of the disclosure of Kajita *et al.*, the "claims were not linked by a special technical feature within the meaning of PCT Rule 13.2, so as to form as single inventive concept, accordingly, the unity of invention is lacking among all groups." (See pg. 3 of Office Action)

Applicants draw the Examiner's attention to co-pending, commonly owned U.S. Application Serial No. 08/969,046 of which the instant application is a continuation-in-part, claiming a related invention and under examination by the same Examiner. In the prosecution of the 08/969,046 application, the Kajita *et al.* reference was asserted as a primary reference and as the basis of rejection of the co-pending claims therein. Applicants' submitted a first Declaration under 37 C.F.R. §1.131 signed by Professor Vincent L. Chiang, a copy of which is attached hereto. The Declaration demonstrated on record that the Kajita *et al.* reference is not an effective reference against the claims of the 08/969,046 application, the claims of which are directed to the same underlying invention as the claims of the instant application. In other words, Applicants showed a completion of the invention such that one of

ordinary skill in the art to a reasonable certainty would recognize that Applicants possessed so much of the invention as to encompass the reference disclosure.


The Examiner found the Declaration persuasive in an Office Action mailed on July 13, 2001, in conjunction with the U.S. Application Serial No. 08/969,046, a copy of which is attached hereto. In that U.S. Office Action, the Examiner specifically states that

“The rejection under 35 USC 103(a) over Kajita et al taken with Huang et al has been withdrawn in view of the 1.131 Declaration filed 11/27/2000. The Examiner of the record has confirmed [has] that the Kajita et al reference was not available until the beginning of 1997 and hence that it is 102(a) type reference. Therefore, the 1.131 Declaration serves to overcome the rejection under 103(a).”

Applicants respectfully submit that in demonstrating that Kajita *et al.* is not a proper reference against the claims of the corresponding U.S. non-provisional application, they have also demonstrated that Kajita *et al.* is not a proper reference against the instant claims. Specifically, the method of claim 1 directed to altering the growth characteristics of plants is not known in the art as evidenced by Kajita *et al.* Accordingly, Kajita *et al.* is not a proper prior art reference in the present U.S. national application. Therefore, the claimed invention is novel and unity of invention is not lacking.

Applicants respectfully request withdrawal of the restriction requirement or, in the alternative, consideration of elected claims 1-28 and 50-53 (Group I) on the merits. No fee is believed due in connection with this submission, however, if a fee is owing, please charge such fee to deposit account no. 13-3080.

Respectfully submitted,



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